

REMARKS

I. Status of the Claims

In the Final Office Action¹ mailed August 20, 2007, the Examiner took the following actions:

- (i) rejected claims 1-9, 12-16, 19, and 20² under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,247,043 B1 to Bates et al. ("*Bates*"); and
- (ii) rejected claims 10, 11, 17, and 18² under 35 U.S.C. § 103(a) as being unpatentable in view of *Bates* and U.S. Patent Application Publication No. 2004/0003071 A1 to Mathew et al. ("*Mathew*").

These rejections were affirmed in the Decision on Appeal mailed July 26, 2010 ("*Decision*").

By this Amendment, Applicants amends claims 1-3, 7, 19, and 20, and add new claims 21-26. No prohibited new matter has been added. Claims 1-26 are now pending.

II. Rejection of Claims 1-9, 12-16, 19, and 20 under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-9, 12-16, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by *Bates*.

In order to properly establish that a reference anticipates Applicants' claims under 35 U.S.C. § 102, each and every element as set for the in the claims must be

¹ The Final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

² The heading on page 2 of the Final Office Action appear to reject claims 1-20 under 35 U.S.C. § 102(b) and the heading on page 8 of the Final Office Action appear to reject claims 10 and 11 under 35 U.S.C. § 103(a). However, page 3 of the Decision clarifies that claims 1-9, 12-16, 19, and 20 are rejected under 35 U.S.C. § 102(b) and claims 10, 11, 17, and 18 are rejected under 35 U.S.C. § 103(a).

found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131., 8th Ed., Rev. 7 (July, 2008). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

Bates fail to disclose or suggest, all of the features of the amended claims including, among other things, “passively recognizing that a **plurality of contacts are, as a group, repeatedly sent communications** by a member,” as recited in amended independent claim 1 (emphasis added).

In *Bates* “two users that **have corresponded with one another** in the past may be considered to have a greater affinity than two users that have not.” *Bates*, col. 3, lines 34-36 (emphasis added). In *Bates*, affinity between two users is determined by determining whether the number of communications exchanged between one individual user and another individual user exceeds a predetermined threshold. *See Bates*, col. 15, lines 22-41. Such a disclosure, however, does not constitute “passively recognizing that a **plurality of contacts are, as a group, repeatedly sent communications** by a member,” as recited in amended independent claim 1 (emphasis added). This is at least because there is no disclosure in *Bates* of determining whether a member has repeatedly sent communications to a plurality of contacts as a group. At most, *Bates* merely discloses determining a number of times a particular user sends communications to another user.

On pages 5 and 6 of the Decision, the Board of Patent Appeals and Interferences (“Board”) states that “Claim 1 does not place any limitation on what a ‘set’ means We agree with the Examiner that a set can possible contain 0, 1, or an infinite amounts

of objects We agree with the Examiner that Bates teaches 'passively recognizing that a set of contacts are, as a group' . . . 'by teaching **an individual user** who is passively recognized as a group of on[e] and a **set of one**.'" (Emphasis added).

As noted above, amended independent claim 1 recites that "**a plurality of contacts** [are] repeatedly sent communications by a member." Accordingly, Applicants assert that the Board's rationale for affirming the rejection of claims 1-9, 12-16, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by *Bates* is no longer valid.

For at least the foregoing reasons, *Bates* fails to disclose or suggest each and every feature of claim 1 and Applicants submit that independent claim 1 is allowable over *Bates*.

Amended independent claims 19 and 20, although of different scope, recite features similar to those discussed above for claim 1, and therefore are also allowable over the cited references for at least reasons similar to those for claim 1. Further, claims 2-9 and 12-16 depend from independent claim 1, and are also allowable at least due to their dependence from an allowable base claim, and further in view of the additional features of these claims.

III. Rejection of Claims 10, 11, 17, and 18 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 10, 11, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable in view of *Bates* and *Mathew* because a *prima facie* case of obviousness has not been established with respect to these claims.

Claims 10, 11, 17, and 18 depend from independent claim 1, and thus require all elements of claim 1. As set forth above, *Bates* fails to teach or suggest each and every element of claim 1. Further, *Bates* also does not render obvious each and every feature

of claim 1. For example, there is no disclosure in *Bates* of the claimed “passively recognizing that a plurality of contacts are, as a group, repeatedly sent communications by a member,” as recited in amended claim 1. Moreover, *Mathew* does not compensate for the deficiencies of *Bates*. This is at least because *Mathew* also does not teach or fairly suggest the claimed “passively recognizing that a plurality of contacts are, as a group, repeatedly sent communications by a member,” as recited in claim 1.

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established for claims 10, 11, 17, and 18. Accordingly, the Examiner should withdraw the § 103 rejections of claims 10, 11, 17, and 18.

IV. New Claims 21-26

New independent claim 21, though of different scope from claim 1, recites features similar to those discussed above in connection with claim 1. In addition, claim 21 recites other features that are neither disclosed nor suggested by the prior art of record, including the features of “enabling the member to share a copy of the contacts list with an additional user through use of the name associated with the contacts list.” Accordingly, for at least the above reasons, new claim 21 is also allowable over the prior art of record and should be timely allowed. Furthermore, new claims 22-26 are also allowable at least due to their dependence from claim 21 and further in view of the features recited by these claims.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: _____


Philip J. Hoffmann
Reg. No. 46,340